

REMARKS

The November 21, 2005 non-final Office Action has been reviewed and its content carefully noted. Favorable reconsideration of this case is respectfully requested. Claims 1 and 3-10 are pending in this application and are currently rejected.

Applicants have amended claims 1 and 5 to clarify that the method of the present invention is directed to reducing contaminants in dredged material via at least one oxidation process and that by adding liquid to the dredged material in step (b) a slurry is formed. Support for the claim amendments may be found *inter alia* in the specification on page 2, paragraph 6. Claim 4 has been cancelled. Claim 6 has been amended to properly depend from claim 1.

**Claim Rejections – 35 U.S.C. §112**

The Examiner has rejected claims 3, 4 and 6 under 35 U.S.C. §112, second paragraph, as being indefinite stating that in claims 3 and 4 “the at least one oxidation process” lacks antecedent basis, claim 4 appears to be duplicative of claim 3 and claim 6 erroneously depends from claim 2, a cancelled claim.

Applicants have amended claim 1 to provide a proper antecedent basis for claim 3, claim 4 has been cancelled and claim 6 has been amended to depend from claim 1. In light of the amendments to the claims, the Examiner’s rejection should be withdrawn.

**Claim Rejections – 35 U.S.C. §103****US 5,795,285 to McLaughlin et al. in view of US 6,428,705 to Allen et al.**

The Examiner has rejected claims 1 and 3-10 under 35 U.S.C. §103(a) as being unpatentable over US Patent No. 5,795,285 to McLaughlin et al. (“McLaughlin”) in view of US 6,428,705 to Allen et al. (“Allen”) stating that it would have been obvious to modify the method of McLaughlin by utilizing the recited oxidation process in view of the teachings of Allen.

Applicants respectfully traverse the Examiner's rejection as being improper in view of MPEP §2143, which provides

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Applicants respectfully traverse the Examiner's rejection because the Examiner has not set forth where the motivation lies in either McLaughlin or Allen to combine the teachings of the references. McLaughlin teaches treating contaminated sediments by plasma melting dredged sediments to destroy hazardous organics and converting the contaminated particles into a low-leachability glass product. (Col 1, lines 14-18). The vitrification process yields a solid product that encapsulates the contaminated particles. There is no treatment per se of contaminants in McLaughlin. Instead, the contaminants are encased within a solid, stable product. (Col. 2, lines 59-62). To the contrary, Allen teaches a process for removing metals and other inorganic and organic contaminants from large volumes of wastewater in a single pass. (Col. 1, lines 21-24). Allen teaches a two-step process where the wastewater is pretreated to facilitate coagulation and then filtered through membranes. (Col. 5, lines 23-33; 39-41). Because the Examiner has not set forth any basis as to why one skilled in the art would be motivated to make the proposed combination, the rejection is improper and should be withdrawn.

The Examiner asserts that Allen discloses that it is known in the art to add oxidizing agents to dredged material to aid in the removing of metals and organic materials. See November 21, 2005 Office Action, p. 2. Applicants respectfully point out that nowhere in the Allen disclosure is there a reference to dredged material. Allen is specifically directed to the treatment of wastewater where the solids content is nominal. To the contrary, claim 1 requires

that a slurry of dredged material be treated, where the solids content is not nominal. One skilled in the art would not be motivated to combine the references' teachings because one teaches the treatment of dredged sediments while the other teaches the treatment of wastewater. Because no teaching or suggestion has been set forth as to why one skilled in the art would make the suggested combination or modification to arrive at the presently claimed invention, the rejection should be withdrawn.

Applicants respectfully submit that McLaughlin and Allen are non-analogous art. MPEP §2141.01(a) provides

In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

The McLaughlin and Allen teach two very different ways to deal with contaminants. Moreover, the waste streams being treated are not the same. McLaughlin teaches treating contaminated sediments by plasma melting dredged sediments to destroy hazardous organics and converting the contaminated particles into a low-leachability glass product. While, Allen teaches a process for removing metals and other inorganic and organic contaminants from large volumes of wastewater in a single pass. The art in McLaughlin pertains to treating dredged sediment by vitrification while the art in Allen pertains to treating wastewater. A person of ordinary skill in the art would not reasonably have expected to solve the problem of treating contaminated dredged material by considering a reference dealing with removing contaminants from large volumes of wastewater. Because McLaughlin and Allen pertain to non-analogous art, the Examiner's rejection is improper and should be withdrawn.

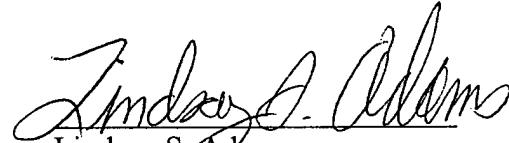
Furthermore, the combination or modification of the references in the manner suggested by the Examiner would change the principle of operation of McLaughlin. MPEP §2143.01 states:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

McLaughlin teaches that sediments may be treated by removing or destroying the contaminants in order to allow for disposal. (Col. 2, lines 34-39). However, processing costs for such treatments considered as potentially viable are very high. *Id.* To cure this deficiency, McLaughlin provides an economical solution to the sediment decontamination problem, that is, converting hazardous material into stable, low-leachability glass suitable for subsequent use. (Col. 2, lines 51-62). Contrary to the principle of operation of McLaughlin, Allen teaches using oxidation to facilitate removal of contaminants. Combining the two references as proposed by the Examiner changes McLaughlin's principle of operation because McLaughlin's invention was designed to eliminate any extraneous treatment of contaminants. The idea being that contaminated material would forego treatment and simply be encapsulated in a solid, stable medium. Because the proposed combination would change the principle of operation of McLaughlin, there has been no *prima facie* case for obviousness set forth and the Examiner's rejection should be withdrawn.

Applicants respectfully submit that this application is in condition for allowance. Early and favorable action is earnestly solicited. If any additional fee is due, the amount of such fee may be charged to Deposit Account No. 50-1145.

Respectfully submitted,



Lindsay S. Adams  
Registration No. 36,425

Liza Negron  
Registration No. 45,731

Attorneys for Applicants

Pitney Hardin LLP  
7 Times Square, 20<sup>th</sup> Floor  
New York, New York 10036  
(212) 297-5800